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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,536	03/25/2004	Masahiko Kurauchi	US-169	5925

38108 7590 03/15/2005

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EXAMINER	
JOHNSEN, JASON H	
ART UNIT	**PAPER NUMBER**
1623	

DATE MAILED: 03/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/808,536	KURAUCHI ET AL.	
	Examiner	Art Unit	
	Jason H. Johnsen	1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) *8-13* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-7, 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *10/22/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d) filed on 09/27/2001.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 10/22/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the examiner is considering the information disclosure statement.

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-7, and 14) is acknowledged. The traversal is on the ground(s) that a search of the entire application can be made without a serious burden nor would the search constitute a non-coextensive search to examine all the claims together. This is not found persuasive because a search of methods for activating a cell would not necessarily encompass the methods of promoting the growth of a plant. In the instant application, because of the extremely broad language, the methods of Group II and III can be classified in completely divergent and unrelated classifications. Therefore, because of the plethora of classes and subclasses in each of the Groups, a serious burden is imposed on the examiner to perform a complete search of the defined areas.

Moreover, a reference rendering one of the groups obvious would not necessarily render the other obvious and a search for one of the groups is not required for the others. As such, a search of the independent and distinct inventions of groups I-III would indeed impose an undue burden upon the examiner in charge of the instant application. Therefore, because these

inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

Claims 8-13 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

1. Claims 1, 2, and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunio Tsuji (JP 8-27008). Claim 1 is drawn to an inosine L-arginine salt. Claim 2 further limits the compound of claim 1, wherein the inosine and L-arginine are present in substantially equimolar amounts. Claims 5-7 are drawn to a composition comprising the inosine L-arginine

salt, a composition in aqueous solution, and a composition wherein the inosine and L-arginine are present in substantially equimoloar amounts.

Kunio Tsuji discloses nucleoside salts, and presents an example with inosine as he nucleoside and an arginine salt as the salt (paragraph 15-17).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare the above taught compound, composition, and method of making said compound and composition having the above-cited references before him. A person skilled in the art could easily conceive of an arginine salt of inosine as well as aqueous solutions of the same. Kunio Tsuji teaches various nucleoside salts, including the combination of inosine as the nucleoside and arginine as the salt.

2. Claims 3, 4, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kunio Tsuji (JP 8-27008).

Claim 3 is drawn to an inosine L-arginine salt produced by the process of dissolving the two products in water, in substantially equimolar amounts, and then drying the dissolution product. Claim 4 teaches the additional step of adding anhydrous ethanol prior to drying. Claim 14 teaches a method of making an inosine L-arginine salt comprising dissolving in water inosine and L-arginine in substantially equimolar amounts, adding the product of the first step to anhydrous ethanol, and drying the product of the second step to obtain the salt.

Claims 3 and 4 fail to further limit the inosine L-arginine compound and composition and are therefore, rejected for the same reason claims 1 and 2 are rejected. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. (MPEP 2113). "[E]ven though product-by-process claims are limited by and defined by

the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Kunio Tsuji teaches the process of making nucleoside salts generally, including dissolving the nucleoside and the amino acid in water (see examples, pages 5 and 6).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to prepare the above taught method of making an inosine L-arginine salt and composition having the above-cited references before him. The process of making said salts, which is described by Kunio Tsuji, is just a standard acid/base reaction and would easily fall within the purview of one of ordinary skill, including the addition of anhydrous ethanol, which is a well known and widely available solvent used in such reactions.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jason H. Johnsen** whose telephone number is **571-272-3106**. The examiner can normally be reached on Mon-Friday, 8:30-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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